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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/655,273	09/05/2000	C. Douglass Thomas	CDTP006	8031

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C Douglass Thomas
1193 Capri Drive
Campbell, CA 95008

EXAMINER
RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
2164	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/655,273	THOMAS, C. DOUGLASS
	Examiner	Art Unit	
	Sam Rimell	2164	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _6-12,16,17,19,20 and 22-33_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _6-12,16,17,19,20 and 22-33_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6-12, 16-17, 19-20, 22-23 and 33 are rejected under 35 U.S.C. 101 because the claimed invention is non-statutory.

Claim 19: Claim 19 is a method which results only in a determination. A determination is not a tangible result, and thus the claim is non-statutory. Additionally, the preamble of claim 1 states that the invention is directed to a "program storage device" which is defined in applicant's specification at page 26, lines 28-32 as including "carrier waves" which are intangible. See State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) for the requirement of a tangible result.

Claims 6-12, 16-17, 20, 22-23 and 33: Depend from claim 19.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 6-11, 16-17, 19-20, 22-24 and 27-31 rejected under 35 U.S.C. 103(a) as being unpatentable over Freivald et al. (U.S. Patent 5,898,836) in view of Glogau (U.S. Patent 5,983,351).

The reasons for this rejection were set forth in the office action of July 13, 2005 and are hereby incorporated by reference.

Claims 12, 25, 26, 32 and 33 rejected under 35 U.S.C. 103(a) as being unpatentable over

Freivald (U.S. Patent 5,898,836) in view of Glogau (U.S. Patent 5,983,351) and further in view

of Information Today.

The reasons for this rejection were set forth in the office action of July 13, 2005 and are

hereby incorporated by reference. .

<div align="center">Remarks</div>

Applicant's arguments have been considered.

Applicant traverses the rejection of claim 19 under 35 USC 101, in light of the

amendment to claim 19 reciting a "program storage device readable by a machine tangibly

embodying a program of instructions executable by a machine." Two problems arise from this

amendment: (1) The specification defines program storage systems at page 26, lines 28-32 as

including carrier waves, which are not considered to be tangible. (2) The specification does not

define what the applicant considers to be "tangible", although it is set forth in claim 19. Given

these two facts, the skilled artisan reviewing the disclosure would be led to believe that the

"tangible embodiment" includes an embodiment of a program in carrier waves, which is non-

statutory. Accordingly, the claimed invention set forth in claim 19 remains non-statutory.

Applicant traverses the rejection of claims, 6-12, 16-17, 19-20, 22-24 and 27-31 as being

taught by the combination of Freivald and Glogau.

(A) Applicant argues that neither Freivald nor Glogau teach determining that a copyright

registration is needed. This argument is not correct. Freivald teaches the fundamental concept of

determining that an update is needed on a webpage after measuring a CRC value indicating a

degree of change. The update action is Freivald is an updating of links. Glogau teaches that after

reviewing website content, a different manner of update can be made, namely, a copyright registration. Glogau is therefore applied to teach the copyright registration as the update action. Applicant's assertion that neither reference teaches updating actions are incorrect, as both references teach the updating action.

(B) Applicant asserts that there is no reasonable expectation of success in the combination of Glogau and Freivald. However, applicant's arguments appear to be indicating that the combination would operate successfully, under several different scenarios, such as a 2% change to a webpage or 100% change of a webpage. These arguments appear to be suggesting that the combination would be successful as a combined set of teachings, so it is not understood why an argument is made that success cannot be achieved. It is also noted that while applicant finds fault with a combination of teachings that would permit updating with 2% detected change or 100% detected change, applicant's own claimed invention has these exact same characteristics. Claim 19 as recited would also permit updating when 2% change or 100% change is detected.

(C) Applicant argues that there is no motivation to combine Freivald and Glogau. This argument is not correct. The motivation for combination is recited on page 5 last paragraph of the office action dated July 13, 2005.

Applicant traverses the rejection of Freivald and Glogau as applied to claim 24 as follows:

(A) Applicant argues that neither Freivald nor Glogau teach storing prior registration information or subsequent registration information. These arguments are not correct. Glogau teaches the basic concept of initiating copyright registration. All copyright registrations, be it

"prior registrations" or "subsequent registrations" are stored by the U.S. Copyright Office. Additionally, the system of Glogau has the capacity to store copyright registration forms and data in a database (col. 2, lines 60-65). Any registrations completed prior to any arbitrary date are stored prior registrations, and any registrations completed after the arbitrary date are stored subsequent registrations.

(B) Applicant argues that Freivald does not teach determining that a copyright registration is needed, or that subsequent registrations are needed. This argument is not correct. Freivald teaches the fundamental concept of determining that an update is needed on a webpage after measuring a CRC value indicating a degree of change. The update action is Freivald is an updating of links. Glogau teaches that after reviewing website content, a different manner of update can be made, namely, a copyright registration. Glogau is therefore applied to teach the copyright registration as the update action. Applicant's assertion that neither reference teaches updating actions are incorrect, as both references teach the updating action.

(C) Applicant argues that initiating subsequent copyright registration is not taught by Freivald or Glogau. This argument is not correct. Glogau has no limitation on the number of copyright registrations which it can perform. There is no suggestion that the Glogau system performs only one copyright registration and then suddenly crashes and becomes permanently disabled. The system of Glogau is clearly capable of multiple registrations. Additionally, skilled artisan would readily recognize that merely duplicating the same registration process over and over again would have been obvious (MPEP 2144.04 (VI)(B)).

(D) Applicant argues no expectation of success exists with the combination of Glogau and Freivald. However, applicant provides no specific rationales or evidence for this assertion in

the argument. Applicant's arguments are primarily addressed to specific features alleged as lacking, rather than the issue of expectation of success.

(E) Applicant argues that no motivation to combine Glogau and Freivald is presented. This argument is not correct. The motivation for combination is recited on page 5 last paragraph of the office action dated July 13, 2005.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.

Sam Rimell
Primary Examiner
Art Unit 2164